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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO
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EXAMINER	
TURNER, S.	
ART UNIT	PAPER NUMBER
129	8

DATE MAILED: 05/22/86

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-18 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-18 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).

10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☒ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

The references cited and supplied by applicants have been made of record.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claims 1-18 are in this case.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The factual inquiries set forth in Graham v. John Deere Co. that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are summarized as follows:

> 1. Determining the scope and contents of the prior art;

2. Ascertaining the differences between the prior art and the claims at issue; and
3. Resolving the level of ordinary skill in the pertinent art.

Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

Claims 1-18 are rejected under 35 U.S.C. 103 as being unpatentable over Taylor, et al. in combination with Stenlake, et al. Taylor, et al disclose a class of isoquinoline compounds which differs from those of the instant claims only by having one less alkoxy group on the benzyl radical. Stenlake, et al. disclose the reverse esters of the compounds of the instant claims and teach that the benzyl ring may have 1, 2, or 3 alkoxy groups substituted thereon. Each of the references teach the same utility as the compounds of the instant claims. It would be obvious for one of ordinary skill in the art substitute there methoxy groups onto the benzoyl ring of the Taylor, et al. compounds as taught by Stenlake, et al. to obtain the compounds of the instant claims.

Claims 13-15 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are substantial duplicates of claim 1 since no distinction can be seen in the compounds of claims 13-15 and claim 1.

Claims 1-18 are rejected.

Any inquiry concerning this communication should be directed to Examiner J. H. Turnipseed at telephone number 703-557-3920.

GLENNON H. HOLLRAH
SUPERVISORY PATENT EXAMINER
ART UNIT 129

JHT
Turnipseed:ebw
5/21/86